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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/927,628 | 08/10/2001 | Andrew H. Pritchard | CF/ 024 | 5363 |
| 64558 | 7590 | 11/16/2007 | | |
| ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704 | | | EXAMINER AKINTOLA, OLABODE | |
| | | | ART UNIT 3691 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/927,628

Applicant(s)

PRITCHARD, ANDREW H.

Examiner

Olabode Akintola

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,17-21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,17-21 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/12/2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitations in this claim do not have support in the originally filed disclosure. Applicant is requested to cite relevant portion(s) of the original disclosure that teaches these limitations.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The bases upon which the act of selecting the investment instrument as recited in claim 5 (plurality of values stored in the database) conflicts with that recited in claim 1 (risk/return preference of the user).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 4-7, 17-21 and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tull, Jr. et al (US 5946667) (Tull) in view of Wallman (US 6601044) (Wallman).

Re claims 1, 20 and 30: Tull teaches a method comprising: selecting, on behalf of a user, an investment instrument from a plurality of investment instruments (col. 3, line 62 - col. 4, line 3); storing the selected investment instrument in an investment trust, in which the investment trust comprises a plurality of selected investment instruments and is traded as a single security on an exchange (col. 6, lines 14-24); transmitting a request to trade at least one share of the investment trust, in which the at least one share corresponds to an ownership interest in a percentage of each selected investment instrument of the investment trust (col. col. 6, lines 14-24); receiving a request to redeem the at least one share for a corresponding ownership interest in the investment trust (col. 4, lines 16-19); and transmitting a value associated with the corresponding ownership interest (col. 4, lines 16-19).

Tull does not explicitly teach receiving at least one risk/return preference associated with a user; selecting, on behalf of the user, an investment instrument from a plurality of investment instruments, in which the act of selecting is based on at least one risk/return preference of the user. Wallman in the same field of endeavor teaches receiving at least one risk/return preference associated with an user; selecting, on behalf of the user, an investment instrument from a plurality of investment instruments, in which the act of selecting is based on at least one risk/return preference of the user (abstract, col. 14, lines

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29-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tull to include this feature as taught by Wallman. One would have been motivated to do so in order to ensure that the selected instrument satisfy the investor's risk and return selection or other preferences that the investor may have.

Re claims 2 and 21: Tull teaches generating a database of investment instruments that is available for selection (col. 8, lines 50-54).

Re claim 4 and 23: Tull teaches determining a plurality of values associated with the investment instrument at a plurality of times; and storing the plurality of values in a database (col. 17, lines 41-45).

Re claims 5 and 24: Tull teaches wherein the act of selecting the investment instrument is based on the plurality of values stored in the database (col. 17, lines 41-56).

Re claims 6 and 25: Tull teaches receiving a request for a financial report; generating the financial report; and transmitting the financial report to the user (col. 3, lines 42-45).

Re claims 7 and 26: Tull teaches: determining that the investment instrument has expired; and replacing the expired investment instrument with a second similar investment instrument (col. 4, lines 16-18).

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Re claims 17 and 27: Tull teaches the investment instrument comprises at least one of: a stock, a bond, a debt instrument, an exchange traded-fund, a mutual fund, a currency, a commodity, an equity investment, a futures investment, and a dividend-paying investment (abstract).

Re claims 18 and 28: Tull does not explicitly teach wherein the risk/return preference comprises at least one of: a growth in equity that is selected by the user, a rate of return that is selected by the user, and a level of risk that is selected by the user. Wallman teaches wherein the risk/return preference comprises at least one of: a growth in equity that is selected by the user, a rate of return that is selected by the user, and a level of risk that is selected by the user (col. 14, lines 29-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tull to include this feature as taught by Wallman. One would have been motivated to do so in order to ensure that the selected instrument satisfy the investor's risk and return selection or other preferences that the investor may have.

Re claims 19 and 29: Tull does not explicitly teach wherein the act of selecting the investment instrument further comprises at least one of: determining that a growth in equity of the investment instrument is greater than the growth in equity selected by the user; determining that a rate of return of the investment instrument is greater than the rate of return that is selected by the user; determining that a level of risk of the investment instrument is less than a level of risk selected by the user; determining that a growth in equity of the investment instrument is greater than the growth in equity provided by each

of the plurality of investment instruments; determining that a return in yield of the investment instrument is greater than the return in yield provided by each of the plurality of investment instruments; and determining that a level of risk of the investment instrument is less than the level of risk selected by the user. Wallman teaches this limitation at col. 14, lines 29-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tull to include this feature as taught by Wallman. One would have been motivated to do so in order to ensure that the selected instrument satisfy the investor's risk and return selection or other preferences that the investor may have.

Response to Arguments

Applicant's arguments filed 9/12/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that neither Tull or Wallman teaches "selecting, on behalf of the user, an investment instrument." Wallman explicitly teaches "...investor's PC to select a plurality of assets to be in the investor's portfolio based on the investor's indicated preferences,..." (see abstract).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, selection of investment instrument using mathematical algorithm and/or risk/return preference of a user are old and well known means of selecting investment instruments.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olabode Akintola whose telephone number is 571-272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HANI M. KAZIMI
PRIMARY EXAMINER